



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,344	05/19/2004	Makoto Shiraga	FUJA 21.179	6718
26304	7590	01/30/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			BHATTACHARYA, SAM	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	

2688

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/849,344	Applicant(s) SHIRAGA ET AL.	
	Examiner Sam Bhattacharya	Art Unit 2688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040519</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Bicker et al. (US 2005/0096024).

Regarding claim 1, Bicker discloses a method for forwarding an incoming call from a cellular phone to an IP phone (via a wireless LAN) in a communication system in which speech communication is carried out on an Internet Protocol network, including a first step in which,

Art Unit: 2688

when a call arrives at a called cellular phone from a calling IP phone, a called person operates a called IP phone, to which the incoming call is to be forwarded, whereby a wireless communication is carried out between the called IP phone and the called cellular phone (see FIGS. 1 and 4 and paragraph [0021], lines 1-8), and a second step in which, after the first step, a function built in the called IP phone, to which the incoming call is to be forwarded, automatically communicates with the calling IP phone, so that the incoming call to the called cellular phone is forwarded to the called IP phone to which the incoming call is to be forwarded (see paragraph [0018], lines 16-25).

Regarding claim 2, Bicker discloses that the communication system is comprised of a storage device in which an identification number of the IP phone is registered, and, in the second step, the function built in the called IP phone, to which the incoming call is forwarded, automatically communicates with the storage device and the calling IP phone (see paragraph [0021], lines 8-10).

Regarding claim 3, Bicker discloses that the communication system is comprised of a switching device 138 in which an identification number of the IP phone is registered, and in the second step, the function built in the called IP phone, to which the incoming call is to be forwarded, automatically communicates with the switching device and the calling IP phone. See paragraph [0010], lines 1-9 and paragraph [0020], lines 11-16.

Regarding claim 4, Bicker discloses a method for switching a call from a cellular phone to an IP phone (via a wireless LAN) in a communication system in which a speech communication is carried out on an Internet Protocol network, comprised of a first step in which, when a call arrives at a called cellular phone from a calling IP phone, the called person operates

Art Unit: 2688

an called IP phone, to which the incoming call is to be forwarded, thereby a wireless communication is carried out between the called IP phone and the called cellular phone (see FIGS. 1 and 4 and paragraph [0021], lines 1-8), a second step in which after the first step, a function built in the called IP phone, to which the incoming call is to be forwarded, automatically communicates with the calling IP phone, a third step in which the function built in the called IP phone which is communicating with the cellular phone disconnects the communication (see paragraphs [0013] and [0014]), a fourth step in which the IP phone which have been communicating with the cellular phone makes a call to the IP phone, to which the incoming call is to be forwarded, thereby the speech communication is switched to the IP phone to which the incoming call is to be forwarded (see paragraph [0018], lines 16-25).

Claim 5 incorporates the limitations of claims 2 and 4, and is therefore rejected for the same reasons as claims 2 and 4.

Regarding claim 6, Bicker discloses that, in the fourth step, when the communication is switched from the cellular phone to the IP phone, to which the incoming call is to be forwarded, the person who received the call can recognize the switching by a ringtone of the forwarded IP phone (see paragraph [0012]).

Claim 7 incorporates the limitations of claims 5 and 6, and is therefore rejected for the same reasons as claims 5 and 6.

Claim 8 incorporates the limitations of claims 3 and 4, and is therefore rejected for the same reasons as claims 3 and 4.

Claim 9 incorporates the limitations of claims 6 and 8, and is therefore rejected for the same reasons as claims 6 and 8.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jacobi et al. (US 6,584,095) discloses interconnected networks that include cellular and IP phones.


Evslin (US 2005/0009525) discloses routing of a call from an IP network to a cellular phone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Bhattacharya whose telephone number is (571) 272-7917. The examiner can normally be reached on Weekdays, 9-6, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sb


GEORGE ENG
SUPERVISORY PATENT EXAMINER